

30. A computer program product for distributing storable content on information content-mastered media, said media including at least first and second content and a media identifier number, the computer program product comprising:

- signal bearing media bearing programming adapted to
- store a first code related to a first access code on said media, at a first time, obtained in exchange for a first payment;
- provide access to said first content by providing said first access code to a reader apparatus, using said first code, wherein access to said second content is unavailable on the basis of said first code;
- store a second code related to a second access code on said media obtained at a second time, later than said first time, in exchange for a second payment; and
- provide access to said second content by providing said second access code to a reader apparatus, using said second code.

REMARKS

Claims 1-30 are pending. Claims 1 and 2 have been amended. Applicant requests reconsideration and reexamination of the pending claims.

Rejection under 35 U.S.C. 102(b):

Claims 1, 4-6, 10-11, 17-22 and 30 are rejected under 35 U.S.C. 102(b) as being unpatentable over Edwards, Jr. (USPN 5,014,234). Applicant respectfully overcomes the rejections as follows.

Claim 1 sets forth, *inter alia*, a method for distribution of storable content "at least some of said storable content readable by at least a first media reader apparatus only in response to at least a first access code...." Applicant could find no teaching or suggestion in Edwards, Jr. of providing access to desired content "only in response to at least a first access code."

In contrast, Edwards, Jr. discloses a method of protection, which "permits unauthorized copies of the protected software to be installed and to operate for a period of time." (Edwards, Jr., col. 3, lines 6-9) Thus, Edwards, Jr. discloses that access is allowed to the protected software without an access code.

Edwards, Jr. does not suggest that access is provided "only in response to at least a first access code," but rather that a "defuse" number is provided upon registration of the

protected software, which is needed not to permit access, but rather “to defuse the checking method and prevent destruction of the protected software.” (Edwards, Jr., col. 4, lines 15-17)

Since Edwards, Jr. neither teaches or suggests Applicant’s invention as set forth in Claim 1, the claim is allowable over the reference.

Claim 17 sets forth, *inter alia*, “copying at least portions of said storable content” to define a copied content “readable by at least a first media reader apparatus only in response to an access code.” Applicant could find no teaching or suggestion in Edwards, Jr. of such a feature for the reasons recited above with regard to Claim 1.

Claim 20 is a method for distribution of storable content including “at least first and second content.” The method includes, *inter alia*, “storing a first code related to a first access code on said media...” and “providing access to said first content by providing said first access code to a reader apparatus, using said first code, wherein access to said second content is unavailable on the basis of said first code.”

Applicant could find no teaching or suggestion in Edwards, Jr. that discloses providing access to first content by providing the first access code to a reader apparatus, using the first code, but making access to the second content unavailable on the basis of the first code. In contrast, Edwards, Jr. discloses that the defuse number is written to FILE F. PROG7 reads FILE F and checks SFILE to see if this is the correct number for the current system. “If it is, the system is defused.” (Edwards, Jr., col. 6, lines 30-40) Thus, Applicant submits that Edwards, Jr. does not teach or suggest that the first code provides access to some but not all of the content. Accordingly, Claim 20 is allowable over Edwards, Jr.

Claim 21 sets forth a method including, *inter alia*, “distributing a plurality of media” each including storable content “readable by at least a first media reader apparatus only in response to an access code.” For reasons stated above with regard to Claim 1, Applicant could find no teaching or suggestion in Edwards, Jr. of the features set forth in Claim 21. Accordingly, Claim 21 is allowable over Edwards, Jr.

Claim 30 sets forth a computer program product for distributing storable content which:

provide access to said first content by providing said first access code to a reader apparatus, using said first code, wherein access to said second content is unavailable on the basis of said first code;

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store a second code related to a second access code on said media obtained at a second time, later than said first time, in exchange for a second payment; and
provide access to said second content by providing said second access code to a reader apparatus, using said second code

Applicant could find no teaching or suggestion in Edwards, Jr. that discloses providing access to first content by providing the first access code to a reader apparatus, using the first code, but making access to the second content unavailable on the basis of the first code. Moreover, Edwards, Jr. does not teach or suggest storing a second code related to a second access code to provide access to second content on the media.

In contrast, Edwards, Jr. discloses that the defuse number is written to FILE F. PROG7 reads FILE F and checks SFILE to see if this is the correct number for the current system. "If it is, the system is defused." (Edwards, Jr., col. 6, lines 30-40) Thus, Applicant submits that Edwards, Jr. does not teach or suggest that the first code provides access to some but not all of the content and that a second code can be used to access some of the remaining content. Accordingly, Claim 30 is allowable over Edwards, Jr.

Rejection under 35 U.S.C. 103(a):

Claims 2, 3, 7, 8, 12-16, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, Jr. in view of Bradley et al. (USPN 5,172,413). Claims 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishio (USPN 5,887,192) in view of Morales (USPN 5,291,554). Applicant respectfully overcomes the rejections as follows.

To establish a prima facie case of obviousness, there must be some suggestion or motivation to modify the reference, there must be a reasonable expectation of success, and the references when combined must teach or suggest all of the claim limitations (see MPEP 2142).

Applicant respectfully submits that there is no motivation to modify or combine the teachings of Edwards, Jr. with Bradley et al. Edwards, Jr. discloses a method for discontinuing the use of un-registered software. Bradley et al. discloses an improved method for the delivery of programming from a plurality of libraries to a plurality of users.

The Examiner has indicated that the motivation stems from the disclosure in Bradley et al. that provides for the educational and entertainment needs of an urban center for incorporating a plurality of residences that can use the library and delivery system as a form of pay TV. Applicant respectfully disagrees with the Examiner that one of ordinary skill in

the art would be motivated by this alleged disclosure to modify the teachings of Edwards, Jr. to arrive at Applicant's invention as set forth in Claims 15.

Claim 15 sets forth, *inter alia*, "receiving a plurality of information content-mastered media in a retail establishment, said information content-mastered media including at least said storable content and a media identifier number, said media readable by at least a first media reader apparatus only in response to an access code...." Applicant could find no teaching or suggestion of this feature in Edwards, Jr.

In contrast, Edwards, Jr. discloses a method of protection, which "permits unauthorized copies of the protected software to be installed and to operate for a period of time." (Edwards, Jr., col. 3, lines 6-9) Thus, Edwards, Jr. discloses that access is allowed to the protected software without an access code.

Edwards, Jr. does not suggest that access is provided "only in response to at least a first access code," but rather that a "defuse" number is provided upon registration of the protected software, which is not needed to permit access, but rather "to defuse the checking method and prevent destruction of the protected software." (Edwards, Jr., col. 4, lines 15-17)

Applicant submits that Bradley et al. fails to cure any of the deficiencies of Edwards, Jr. to arrive at Applicant's invention set forth in Claim 15.

The Examiner has indicated, Edwards, Jr. fails to disclose a retail establishment or that a retail establishment is accessible to a plurality of users. For example, the Examiner has indicated that Bradley et al. at col. 1, lines 13-30 discloses "a retail establishment." Applicant submits that "pay television" would not suggest or teach one of ordinary skill in the art "a retail establishment."

Upon reading col. 5, lines 15-27, Bradley et al. merely discloses providing access to "residences, business and schools throughout an urban centre...." (Bradley et al., col. 5, lines 20-21) In addition, Bradley merely discloses "providing end users with the ability to select programming for delivery to their location when they require it." Applicant fails to find any disclosure in Bradley et al. of a "retail establishment" as set forth in Claim 15.

Since there does not appear to be some suggestion or motivation to modify Edwards, Jr. in view of Bradley et al. that would have any reasonable expectation of success, and the references when combined fail to teach or suggest all of the claim limitations, Claim 15 is allowable over the cited references.

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Claim 24 sets forth a method including, "distributing optical disks including at least a first electronically stored advertisement wherein at least a portion of said optical disk is writeable." Applicant could find no teaching of such an element in Nishio.

In contrast, Nishio discloses an advertisement "recorded as the second image data on a CD-ROM." (Nishio, col. 5, lines 42-43) Applicant could find no teaching or suggestion that the optical disk is writeable. In the manufacture of CD-ROMs it is known that CD-ROMs are stamped by the vendor, and once stamped, they cannot be erased and filled with new data.

Applicant submit that Morales was cited for allegedly disclosing interactive TV, which does nothing to cure the deficiency in Nishio. Accordingly, Claim 24 is allowable over the cited references.

Claims 2-14 depend from Claim 1 and are therefore allowable for at least the same reasons as Claim 1 as well as for the novel features which they add. For example, Claim 2 sets forth "distributing said first permission code via an Internet communications link." Applicant could find no teaching or suggestion either alone nor in combination with Bradley et al. of distributing using an Internet communications link.

Claim 16 depends from Claim 15 and is therefore allowable for at least the same reasons as Claim 15 as well as for the novel features which it adds. Claims 18 and 19 depend from Claim 17 and are therefore allowable for at least the same reasons as Claim 17 as well as for the novel features which they add. Claims 22 and 23 depend from Claim 21 and are therefore allowable for at least the same reasons as Claim 21 as well as for the novel features which they add. Claims 25-29 depend from Claim 24 and are therefore allowable for at least the same reasons as Claim 24 as well as for the novel features which they add.

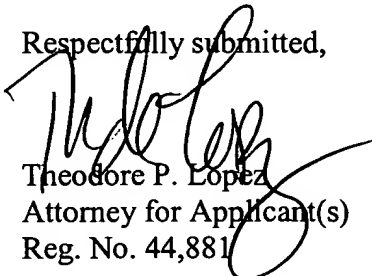
CONCLUSION

In view of the remarks and amendments set forth herein, Claims 1-30 are in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned at (949) 718-5200.

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Respectfully submitted,


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Attachment A
Version with Markings to Show Changes Made

IN THE SPECIFICATION

Please replace the paragraph starting on page 1, line 1 with the following replacement paragraph:

Cross reference is made to U.S. Patent Application Serial No. 09/315,398 of Braitberg, et al., filed May 20, 1996 [(Attorney File No. 4154-1)], 60/140,633, filed June 23, 1999 [6/23/99 (Attorney File No. 4154-2)], and Application Serial No. 09/393,150 [(Attorney File No. 4154-4)], entitled "WRITEABLE MEDIUM ACCESS CONTROL USING A MEDIUM WRITEABLE AREA" filed on even date herewith, all incorporated herein by reference.

Please replace the paragraph starting on page 3, line 21 with the following replacement paragraph:

The present invention includes a recognition of certain problems of previous approaches, including as described herein. In one aspect, the present invention provides for distribution of content by storing content on media in an encrypted or otherwise protected form with the media also [being] having at least a portion which is writeable, e.g., in a user's media reader device, a retail location device, kiosk, vending machine or the like. As used herein, "information content-mastered" refers to a medium in which content is provided on the medium before it reaches the user. A common example is music CD's in which the music is information content-mastered ("ICM") prior to distribution to users. In one aspect, content access information, preferably enabling reading or access to at least portions of the stored content, may be written to or stored on the media, e.g., in exchange for payment. Preferably, the active codes stored on the media are used in conjunction with a media serial number or other media identifier in such a manner that a code which permits access to content on one copy (having a first serial number) will be inoperative to provide access to such content on a second copy (having a second serial number).

Please replace the paragraph starting on page 6, line 20 with the following replacement paragraph:

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As depicted in Fig. 1, in one embodiment media are produced by a production system 112, with the media including serial numbers or other preferably unique (or sufficiently distributed) media identifiers and preferably some media including content, for example, audio, video, or other image, text, software or other storable content, at least some of which is encrypted or otherwise read-protected. The media preferably includes at least a portion which is writeable, such as being serially-writeable. Preferably, the content is provided in a relatively efficient fashion such as by injection molding or other mastering techniques. Methods and apparatus which can be used in connection with fabricating appropriate media, reading such media, and/or protecting content are described, e.g., in U.S. Patent Application No. 09/315,398, filed May 20, 1999, [(Attorney File No. 4154-1)] U.S. Provisional Application No. 60/140,633, filed June 23, 1999, [(Attorney File No. 4154-2 PROV)] or U.S. Patent Application No. 09/393,150, filed on even date herewith [(Attorney File No. 4154-4)]. One or more distribution systems 114 are used for providing such media to users 116 who can, if desired, enable some or all of the protected content 118, e.g., as described below.

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Attachment B
Version with Markings to Show Changes Made

IN THE CLAIMS

1. (Twice Amended) A method for distribution of storable content comprising:
distributing information content-mastered media including at least said storable
content and a media identifier number, to a plurality of users including a first
user, [wherein] at least a portion [some] of said storable content [is .] readable
by at least a first media reader apparatus only in response to at least a first
access code; and
distributing a first permission code to said first media reader apparatus in exchange for
a first payment, said media storing a first code related to said first permission
code at a first time, said first permission code in combination with said first
code providing said first access code and permitting at least a first access to
said at least a portion of said storable content.
2. (Twice Amended) A method, as claimed in claim 1, wherein said step of
distributing [.] comprises distributing said first permission code via an Internet
communications link.

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